

REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on September 16, 2004, the Examiner objected to claims 13-17, and rejected claims 1-12 and 18-23.

Claim Objections

In the Office Action, the Examiner objected to claims 13-17 for failing to comply with 37 CFR 1.121. The listing of claims has been amended in accordance with the Examiner's objection.

Rejections under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1-8, 11, 12 and 20-23 under 35 U.S.C. 102(e) as being anticipated by U.S. Pat. No. 6,434,534 to Walker et al. Applicant respectfully traverses. The standard for a Section 102 rejection is set forth in M.P.E.P 706.02, which provides:

“... for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present.”

The cited reference does not teach every aspect of the claimed invention. Walker is a “method for providing and managing a customized reward offer to a holder of a financial account”. Walker, Abstract, first sentence. The claimed inventions relate to rewarding a customer for making efforts to pay an unpaid debt. Rewarding a customer for good credit habits is not the same as rewarding a customer for making an effort to pay an unpaid debt. Independent claims 1, 11, and 20 are all methods that include multiple steps being performed. In order to properly

anticipate these claims, a reference must teach each aspect of every step NOT just include some reference to a system that may perform the step.

Claim 1 is not anticipated by Walker. In particular, the Examiner cites Column 8, Lines 1-7 to show that Walker anticipates “receiving a request to **collect on an unpaid debt**” and “selectively performing one or more **debt collection procedures** to collect at least a portion of the unpaid debt”. Claim 1, steps 1 and 3 respectively. Column 8, Lines 1-7 of Walker discusses a behavior score which includes numerous characteristics, and wherein the behavior score is used in determining whether to reward a financial customer. As discussed above, this section relates to rewarding a customer but does not relate to rewarding **debt collection efforts**. Neither of the steps are described explicitly or impliedly in the cited section. No indication of “receiving a request” or “performing … procedures” is contained in the cited section. The mere inclusion of a reward system that analyzes a customer’s debt does not anticipate or teach the corresponding steps in claim 1. For at least these reasons, the Applicant requests that the rejection of claim 1 be withdrawn.

Claim 11 is not anticipated by Walker. The Examiner again appears to be citing sections of Walker that do not meet the requirements for anticipation or teaching of the limitations included in this claim. For example, Column 8, Lines 1-7 of Walker does not discuss the step of **“providing the reward … upon providing the unpaid debt…”**. As discussed above, the cited section in Walker merely discusses a behavior score which is used in determining whether to reward a customer. There is no mention of providing a reward in response to a specific task. For at least these reasons, the Applicant requests that the rejection of claim 11 also be withdrawn.

Claim 20 is not anticipated by Walker. The Examiner again relies on Walker, Column 8, Lines 1-7 to teach the step of “receiving a request to collect on an unpaid debt”. As discussed

above, including a behavior score for determining a reward does not anticipate or teach receiving a request to collect on an unpaid debt. For at least these reasons, the Applicant requests that the rejection of claim 20 also be withdrawn.

Claims 2-8, 12 and 21-23 are dependent from claim 1, 11, or 20 and therefore should be allowable for at least the same reasons.

Rejections under 35 U.S.C. § 103

A. Claims 9 and 10

In the Office Action, the Examiner rejected claims 9 and 10 under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,434,534 to Walker et al. Claims 9 and 10 are dependent from claim 1 and are therefore for at least the reasons stated above.

B. Claims 18 and 19

In the Office Action, the Examiner rejected claims 18 and 19 under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,434,534 to Walker et al. in view of U.S. Pat. No. 6,052,674 to Zervides et al. Applicant respectfully traverses.

To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation . . . to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2142. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. *In re John R. Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). Any such suggestion must be found in the

prior art, and not based on applicants disclosure. *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991). A clear and particular showing of the suggestion to combine is required to support an obviousness rejection under Section 103. *Id.* For the reasons set forth below, Applicant submits that the prior art fails both to teach or suggest all the claim limitations, and to clearly and particularly suggest the combination indicated by the Examiner; thus, Applicants claims are not obvious in view of the prior art references.

Walker and Zervides do not teach every element of claim 18. The Examiner again relies on Column 8, Lines 1-7 of Walker to teach the step of, “receiving a request to perform the debt collection service to collect on an unpaid debt”. As discussed above, including a behavior score for determining a reward does not anticipate or teach receiving a request to collect on an unpaid debt. The Examiner also relies on Column 8, Lines 1-7 of Walker to teach the step of, “selectively performing one or more debt collection procedures to collect at least a portion of the unpaid debt”. The paragraph cited by the Examiner does not discuss any selection process, any types of debt collection procedures, nor does it even mention the concept of unpaid debt. As cited above, an obviousness rejection still requires that the references teach every aspect of the claimed invention. For at least these reasons, the Applicant requests that the rejection of claim 20 also be withdrawn.

Claim 19 is dependent from claim 18 and therefore should be allowable for at least the same reasons.

CONCLUSION

Applicants submit that the comments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicants request favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

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Respectfully submitted,

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